

REMARKS

By the present amendment, Applicants have amended Claims 1 and 10. Claims 4, 9, 13, and 18 have been canceled. Claims 1-3, 5-8, 10-12, 14-17 and 19 remain pending in the present application. Claims 1, 10 and 19 are independent claims.

In the recent Office Action the Examiner rejected Claims 1-3, 6-7, 10-12, 15-16, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Simon (U.S. Patent No. 6,498,920) in view of Blumer et al. (U.S. Patent No. 6,189,019). Claims 4-5 and 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simon in view of Blumer and Papadopolous (U.S. Patent No. 6,099,320). Claims 8-9 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simon in view of Blumer and “Pathlore Learning Management System fills ‘skills gaps’ through strategic partnership with SkillScape,” printed in Business Wire. The cancellation of Claims 4, 9, 13 and 18 by the present amendment serves to render these particular grounds of rejection moot as to those claims.

The claims in this application have been revised to more particularly define applicants' unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the following reasons is respectfully requested.

With respect to independent Claims 1 and 10, Claim 1 has been amended to incorporate the limitations of both dependent Claims 4 and 9, and Claim 10 has been amended to incorporate the limitations of both dependent Claims 13 and 18. Consequently independent Claims 1 and 10 have added limitations requiring the computer product to contain additional instructions, and the software executing on the tool or system to include additional means, causing the design templates to aid in (a) developing and sequencing objectives; (b) specifying instructional

strategies and methods; (c) evaluating instructional objectives; and (d) examining organizational issues, as well as causing the generation of a web application that permits multiple learners to access the course synchronously and asynchronously. The Examiner has not specifically addressed this combination of elements in the present Office Action.

Anticipating that the Examiner may combine the applied references of record in rejecting Claims 4 and 9 on the one hand, and Claims 13 and 18 on the other hand, this would require that one skilled in the art be motivated to combine the teachings of Simon, Blumer et al., Papadopolous, and the Business Wire publication to arrive at the invention of amended Claims 1 and 10.

Applicants first note that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3rd 994, 50 USPQ2d 1614 (Fed.Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill

in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

See also *In re Sang Su Lee*, No. 00-1158 (Fed. Cir. January 2002) (error for Board to hold that obviousness rejection may be based on common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference, citing *Dembiczak* and *Rouffet*, *supra*); *Teleflex v. North America Corp.*, No. 01-1372 (Fed. Cir. June 2002) (in order to show motivation to combine references from prior art itself or the nature of the problem in order to show obviousness, actual evidence is required; a conclusory assertion is insufficient).

Simon merely describes a software application to be run by employees for training in compliance with laws and regulations governing an organization that permits the online quizzes to be edited by management to include custom questions. Blumer et al. is directed towards a method of viewing documents in a hierarchical tree. Papadopolous relates to a teaching tool for training students. The Business Wire publication is a press release describing some sort of learning software that allows collaborative learning, but does not teach software that would write a program that allows for collaborative learning.

In short, none of the references cited by the Examiner, taken either singly or in combination, suggests the integrated system of amended Claims 1 and 10 that provides software for analyzing an organization's training needs and capabilities, software for designing an appropriate training program, and software that parses data relating to those needs and automatically writes a web-based application to address those training needs. Moreover, no motivation has been identified for one skilled in the art to consult all four references to combine their teachings, and the number of references involved makes it unlikely that one skilled in the art would look to all four references. Indeed, the Business Wire publication is merely an announcement of a product for sale that claims the business has a product that does a certain thing, but does not describe how it does that thing in enough detail to enable one skilled in the art to make and practice it without undue experimentation. The applied references of record merely show isolated single elements or limitations of the invention claimed in amended Claims 1 and 10, and even in combination do not show all such elements. For these reasons, Applicants respectfully submit that amended independent Claims 1 and 10, and consequently dependent Claims 2-3, 5-8, 11-12, and 14-17, are patentable over the applied art of record.

With respect to independent Claim 19, Applicants have amended Claim 19 to provide that the user of the analysis templates, and consequently of the design templates as well, is one “charged with designing and developing the job training program for the organization.” No new matter has been added by the amendment. Claim 19, as originally written, was rejected as being unpatentable over Simon in view of Blumer et al. Applicants will explain how Claim 19, as amended, is patentable over the applied art of record.

Applicants point out that prima facie obviousness is not shown if an element or claim limitation is not shown in the references. *In re Fine*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); MPEP § 2145.03. Applicants need not point to all of the elements or limitations not shown by the references. Applicants will simply point to three such deficiencies, and explain how the amendment clarifies that the invention claimed in Claim 19 is patentable over the references.

First, in the Office Action, the Examiner asserted that Simon shows “analysis templates...for assessing the organization’s needs, capacities, and resources”, citing col. 3, lines 31-36, and asserting that “the needs of the individual are organizational needs since the individual is a part of the organization.” The passage in Simon referred to by the Examiner simply describes how an employee logs in to the system, enters his job, and then the web site “generates training content that is tailored to the user’s job function.” That is, the content is selected solely by reference to an individual employee’s job title. Moreover, what is generated is not guidance for a person designing a training program for a group of employees, but a document or form directed towards a single employee. An organization’s needs, capabilities, and resources are different than an individual employee’s needs, capabilities, or resources. In designing a training program for an organization, the organization must create a program capable of training

a group of people who may have different educational backgrounds, different vocational backgrounds, who may or may not have English as their native language, etc. The Simon invention, as described in the passage cited by the Examiner, is an example of a product that might potentially be generated by the present invention in the third set of instructions of Claim 1 or by the web author means of Claim 10, and does not address or provide for analysis and design templates that lead to software that generates a web application. The amendment clarifies this by providing that the user of the analysis and design templates are not the organization's employees in general, but a particular class of the organization's employees, namely, those charged with developing job training programs for the organization. This deficiency is not supplied by Blumer et al.

Second, in the Office Action, the Examiner relies on Simon to show that the processor receives "the user responses to said templates in serialized objects..." A serialized object is a software construct well known to those skilled in the art of computer programming, particularly in object-oriented programming languages, such as, e.g., Java. A serialized object is a particular way of storing data in memory to achieve platform independence. There is absolutely nothing in Simon that refers to object-oriented programming or serialized objects at all. Simon speaks in terms of HTML, which simply works on documents. Blumer et al. does not remedy this deficiency.

Third, in the Office Action, the Examiner asserts that Simon shows a sequence of instructions causing the processor to "parse the serialized objects...and generate a web application implementing a job training course." The Examiner relies upon Blumer to show a document tree providing for links between documents. As mentioned earlier, Simon does not mention or describe serialized objects. Furthermore, Simon does not describe any parsing

software. Still further, one skilled in the art of computer programming would know that a web application is not a collection of linked HTML documents. A web application is a program, i.e., a set of instructions organized to cause a processor to perform any of various tasks, but which operates on a computer connected to a network that uses HTML protocol for communication between computers on the network. Neither Simon nor Blumer remotely suggest software that generates other software that can work on a network for providing job training, much less generating such software by parsing data supplied in response to analysis and design templates.

For these reasons, Applicants respectfully submit that independent Claim 19 is also patentable over the applied art of record.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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